

Election

In response to the July 31, 2007, restriction requirement, assignee elects Group I with traverse. Traversal is on the ground that, although the two groups are independent and distinct, no significant burden is required to examiner both groups, given that the claims of the non-elected group have been examined at least twice before without being amended to insert the point now being used to distinguish the group, and because assignee has argued the same distinction a number of times. If possible, assignee would like to have all claims considered and allowed in the same application and would prefer not to have the delay and expense of a divisional application. Absent reconsideration of the restriction requirement, the claims of Group II stand withdrawn from consideration, and they are so marked in the claim listing above. However, assignee agrees to withdraw the traversal if all Group I claims are allowed as amended above, and appreciates the Examiner's commitment to do what they can to accelerate examination of the divisional. Accordingly, assignee authorizes the Office to cancel the withdrawn claims in a notice of allowability if one is issued.

Remarks

In the interview on July 20th, the Examiner and SPE indicated that they had reviewed the case further and had suggestions for a few additional clarifying changes to the claim language that would result in allowance of most of the claims, when combined with the changes substantially as proposed in assignee's May 10th response. In the interview, the Office representatives advised that the changes now being presented to independent claims 15, 16, and 22 would place those claims in condition for allowance and agreed that similar changes could also result in allowance of claim 25.

Assignee's representative has studied the Examiner's comments in his interview reports dated July 25th (concerning May 10th interview) and 31st (concerning July 20th interview) and responds that the proposed changes follow the Examiner's stated suggestions there. Regarding claim 15, the claim amendments presented here follow the Examiner's suggestion to "distinctly claim the 3 'fields'" as in claim 1 (as acknowledged in the Examiner's July 31st interview report).

Regarding claims 16 and 22, the claim amendments presented here address the Examiner's suggestion of "linking the window of point (1) and (a) in the claim," by use of the phrase, found in amended part (a) of both of those claims, "... further to the message recipient field of part (1)."

As the preambles of claims 16 and 22 make clear, the purpose of the method is to modify an email (or other e-messaging) program so that it displays a message window with extra fields, beyond those conventionally displayed by an unmodified email program. For that reason, assignee has not adopted the suggestion to state that the "*message window*" in part (a) is the same as the window in part (1). Assignee wishes to avoid forcing the reader of these claims to decide the metaphysical question of whether a modified "message window" should be considered the same "message window" as a window that would have been displayed had the program not been modified (but will never be displayed after the program has been modified).

Nevertheless, claims 16 and 22 as amended clearly specify that the method, when performed, displays a message window with "further" fields, and the claim language expressly links the field (to which the further fields are added) to the *field* in the message window of part (1). Nothing in Yamaguchi or other cited references discloses or suggests the concept of performing a method that includes modifying an electronic message program to cause it to display extra fields, separate from the message recipient (usually, "to") field, that allow designation of whether recipients listed in "the message recipient field" have viewing or editing privileges. These claims are clearly patentable.

Turning to claim 25, as explained at the July 24th interview, the amendment specifies that the "indicia" in part (c) are outside the "message recipient field." That limitation clearly distinguishes the Yamaguchi reference previously applied. Specifically, Yamaguchi does not disclose any indicia outside the message recipient field designating addresses in the message recipient field as having viewing or editing privileges. See claim 25, part (c) (requiring "in a location in the electronic message separate from the message recipient field, indicia designating whether addresses entered into the message recipient field are associated with message recipients having

viewing privileges for a file entered into the file identification field and whether such addresses are associated with message recipients having editing privileges for the file”).

At the July 24th interview, the Examiner inquired whether indicia entered into Yamaguchi’s “cc” field could possibly be considered to meet the limitation quoted just above from claim 25, in a hypothetical case where a user of Yamaguchi’s system happened to insert the *same addressee* in *both* the “to” and “cc” fields. First, assignee notes that Yamaguchi does not *teach* any such possibility, and there would be no apparent purpose for any user to place the same recipient in two different fields. Nevertheless, even if such happened to occur, to answer the Examiner’s question, the duplicative entry in Yamaguchi’s “cc” field would not qualify as the “indicia” required by part (c) because that entry would not designate whether or not the recipient listed in the “to” field had privileges. Indeed, the duplicate address’ inclusion in or absence from the “cc” field would not alter in any way the privileges available to a recipient listed in the “to” field, in a system complying with the teachings of the Yamaguchi’s patent. Assignee’s representative understood the Examiner, at the July 24th interview, to agree with this responsive argument, conditioned on reviewing Yamaguchi again.

Also during the interview, the Examiner observed that the “indicia” in claim 25, part (c) need not be contained specifically in a “field.” Assignee’s representative agreed, and has amended the claim by broadening it to require that the indicia be at a “location” (whether or not a field) in the message that is outside the message recipient field.

In response to the Examiner’s inquiry during the interview as to whether claim 25, in part (c), should be interpreted to require indicia identifying *both* viewing and editing, or whether *either* viewing or editing was enough (in view of the presence of the word “or”), assignee has expanded and reworded part (c) to clarify that the indicia (whether consisting of one or two parts, *see, e.g.,* “radio” buttons in Fig. 5, which show an example of indicia separated between viewing and editing) have the capacity of identifying whether a recipient has viewing privileges and whether a recipient has editing privileges, and has made parallel changes to part (d). In connection with that interpretation question, please note, however, that:

- (1) a *particular* recipient may have one or the other privilege type,

(2) if desired, as denoted by numeral 522 in the specific embodiment of Fig. 5, the system optionally may be configured to allow a recipient to have *neither* type of privilege, and

(3) a recipient with editing privileges by definition also has viewing privileges.

The amendments discussed in this paragraph are not needed to overcome any proposed rejection, because the art of record allows either choice, and because no other type of rejection was contemplated or discussed in the interview.

New claim 55 is a substantial counterpart of claim 25 presented in method form and should be allowable for parallel reasons. Claim 56 depends on claim 55 and is similarly allowable.

As also agreed in the interview, to reduce the number of issues, assignee has canceled claim 26 and proposes further amendment to claim 53 for the Office's consideration. Assignee requests careful consideration of amended claim 53.

As the undersigned reminded the Examiner during the interview, the intent with claim 53 is to avoid any issue concerning propagated signal claims, given the currently unsettled state of law on that question. Assignee instead presents a claim that is clearly within both the Office's current Interim Guidelines and the words of 35 U.S.C. §101.

Claim 53 as now amended relies on paragraph [0047] of the specification, which refers to signals passing through the Internet. Assignee requests that the Examiner appreciate that claim 53 is directed to tangible equipment (an Internet computer) in which a signal resides (temporarily), and the signal has functionality when applied to appropriately configured destination equipment. Such a claim arrangement is statutory, because §101 includes a "machine" as well as a "manufacture." Indeed, such a claim is analogous to *Beauregard* claims, which are directed to programs (signals) resident in a computer or on a computer disk; just as those are understood as statutory, so too is claim 53.

Claims 1 and 14 and their dependent claims stand allowed, and no amendments have been presented. All remaining non-withdrawn claims should also now be in condition for allowance. Assignee and the undersigned thank the Office for its further

consideration and respectfully request prompt movement toward allowance of claims 1-25, 44-48, and 53-56.

If any further questions or issues arise, the undersigned invites the Examiner to telephone the undersigned and resolve them promptly.

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by its attorney

Dated: August 30, 2007

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